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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,586	11/09/2001	Toshiro Tsuchida	P21332	5812

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EXAMINER

MARKS, CHRISTINA M

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 07/09/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/986,586

Applicant(s)

TSUCHIDA ET AL.

Examiner

C. Marks

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 November 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Specification*

The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973). The Examiner asserts that the material contained within Japanese Patent Application No. 2001-097576 is essential to the application due to the fact it was incorporated in its entirety. Therefore, since no English translation of the Application is enclosed, the essential subject matter incorporated in its entirety would not be available.

### *Oath/Declaration*

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

The specification to which the oath or declaration is directed has not been adequately identified. See MPEP § 601.01(a).

Further, the oath or declaration is neither signed nor dated by either inventor.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4-5, 10-11, 16-17 and 22-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 recites the limitation "the number of first items" in line 5 and "the number of second items in line 7. There is insufficient antecedent basis for this limitation in the claim. Prior to this claim, the reference is referred to a number of items and there is no support for distinct first and second items.

Claim 5 does not properly define the limitation of the probability of acquiring an item based upon whether the player acquires the items determined by using a first item acquisition factor. One of ordinary skill in the art would not be able to distinctly understand exactly what is incorporated in the language of the claim limitation as it is not properly defined as to exactly what is meant by a determination of whether the "player character acquires an item determined by a factor." The features encompassed by this claim language cannot be readily understood.

Claim 10 recites the limitation "the number of first items" in line 5 and "the number of second items in line 7. There is insufficient antecedent basis for this limitation in the claim. Prior to this claim, the reference is referred to a number of items and there is no support for distinct first and second items.

Claim 11 does not properly define the limitation of the probability of acquiring an item based upon whether the player acquires the items determined by using a first item acquisition

factor. One of ordinary skill in the art would not be able to distinctly understand exactly what is incorporated in the language of the claim limitation as it is not properly defined as to exactly what is meant by a determination of whether the “player character acquires an item determined by a factor.” The features encompassed by this claim language cannot be readily understood.

Claim 16 recites the limitation “the number of first items” in line 4 and “the number of second items in line 6. There is insufficient antecedent basis for this limitation in the claim. Prior to this claim, the reference is referred to a number of items and there is no support for distinct first and second items.

Claim 17 does not properly define the limitation of the probability of acquiring an item based upon whether the player acquires the items determined by using a first item acquisition factor. One of ordinary skill in the art would not be able to distinctly understand exactly what is incorporated in the language of the claim limitation as it is not properly defined as to exactly what is meant by a determination of whether the “player character acquires an item determined by a factor.” The features encompassed by this claim language cannot be readily understood.

Claim 22 recites the limitation “the number of first items” in line 6 and “the number of second items in line 8. There is insufficient antecedent basis for this limitation in the claim. Prior to this claim, the reference is referred to a number of items and there is no support for distinct first and second items.

Claim 23 does not properly define the limitation of the probability of acquiring an item based upon whether the player acquires the items determined by using a first item acquisition factor. One of ordinary skill in the art would not be able to distinctly understand exactly what is incorporated in the language of the claim limitation as it is not properly defined as to exactly

what is meant by a determination of whether the “player character acquires an item determined by a factor.” The features encompassed by this claim language cannot be readily understood.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 7-9, 13-15, and 19-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Ohnuma et al. (US Patent No. 6,375,571).

Ohnuma et al. disclose control method relating to a computer-readable recording medium having a program of a video game recorded therein (FIG 6) wherein player characters are assigned predetermined parameters in the form of items that can be changed when the player character defeats an enemy character (FIG 15). This computer-readable recording medium is in the form of a gaming apparatus and the program inherently controls the processing that occurs within the device.

Upon execution, the computer will compare an amount of damage inflicted on the enemy character by the player character each time the player character attacks, including before and immediately before the player character defeats the enemy (Column 15, lines 50-57). Each enemy character has a threshold value set in the form of hit points. When the amount of damage done by the player character is not equal to the threshold value, the player parameter is changed

by a first value (Column 15, lines 51-55). When the amount of damage is at least equal to the threshold value and the enemy is defeated, the player parameter is changed by a second value (Column 15, lines 55-59).

The player parameter is associated with the process of gaining items based upon the result of the battle (Column 15, lines 57-59). When the amount of damage is less than the threshold value, Ohnuma et al. do not disclose the exact result but it is inferred that the player parameters relating to the number of items stored for the player is raised by a first value equal to zero (Column 15, lines 48-51). When the amount of damage is at least equal to the threshold value, Ohnuma et al. disclose that the parameter is raised by a second value, wherein the player can acquire certain items for the win (Column 5, lines 55-59) thus increasing the number of items is increased. Therefore, this parameter can be directly associated with the number of items acquired by the player for the defeat.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 4-5, 10-11, 16-17 and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohnuma et al. (US Patent No. 6,375,571) in view of Kondo et al. (US Patent No. 6,347,993).

What Ohnuma et al. disclose has been discussed above and is incorporated herein.

Kondo et al. teach of a battle method wherein a player character engages with an enemy character. A time threshold is set as the time it would take to defeat the enemy character. The player is also awarded points to help their character develop for each segment of time passed with the number of points being more the closer the player gets to the threshold value of defeating the character (see for example Column 21, lines 13-40). A first number of points is stored if the player performs less than the threshold value and a second number of points is stored if the player meets the threshold. The points obtained by the character are used to supplement parameters to support the character development, growth, and strength.

It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the teachings of Kondo et al. into the system of Ohnuma et al. By applying these teachings, the player character would be rewarded points for their effort in battling the character, not just for defeating the character. One of ordinary skill in the art would be motivated to make this incorporation, as it would provide motivation to the players, as it would reward them for good attempts, not just for victory. This would keep the players encouraged as well as allow them to slowly develop their character to the point where they will be able to defeat the enemy character, thus promoting play and keeping the interest of the player as they would feel more



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successful as they would be awarded more often. Further, it would have been an alternative design alternative to award the players different types of items based upon the points obtained as disclosed by Kondo et al.

One of ordinary skill in the art understands that in a role-playing game as disclosed by both Kondo et al and Ohnuma et al., it is notoriously well known in the art that magic or other weapon items can be obtained by reaching a certain point level or acquisition factor. It would have been obvious to one of ordinary skill in the art that as a design alternative to awarding the player points based upon nearness to the threshold value as disclosed by Kondo et al., the players could be awarded different items (as opposed to different points) based upon how close they came to defeating the character. This would be synonymous with the awarding of items disclosed by Ohnuma et al.

Likewise, by awarding points as currently disclosed by Kondo et al., the gaming system is essentially awarding a probability of acquiring an item, as it is disclosed above that it is notoriously well known in the art that acquisition factors are used in awarding items wherein higher acquisition factors are associated with more powerful items, and by awarding points, the system would be essentially naming the probability value as the points awarded would be a probability function of the total points needed to acquire the item.

Claims 6, 12, 18 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohnuma et al. (US Patent No. 6,375,571).

What Ohnuma et al. disclose has been discussed above and is incorporated herein.

Though Ohnuma et al. disclose information can be communicated over a network (Column 12, lines 55-57), Ohnuma et al. do not specifically disclose play can commence over the network. However, it is notoriously well known in the art and understood by one of ordinary skill in the art that role-playing games can be played over a network wherein players can interact with numerous players from around the world. This feature increases excitement in the game, as there are an endless number of enemies to battle and friends to make. Such a feature would be obvious to Ohnuma et al.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**US Patent No. 6,261,179:** Role-playing game wherein a score-giving condition is detected according to the relation of the player object to another object. Further, when it is determined the player object made a hit on an enemy object, the damage amount of the enemy is reduced and points are provided for the player.

**US Patent No. 6,533,663:** Role-playing game wherein when the fight ends, the player character is awarded with an increase in the experience playing parameter.


**US Patent No. 6,358,148:** Summary provides a description of RPG methodology as well as disclosing that a player is awarded ability value points for defeating enemy characters.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Marks whose telephone number is (703)-305-7497. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:30 PM).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael O'Neill, Acting SPE, can be reached on (703)-308-3484. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9302 for regular communications and (703)-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1148.

  
cmm  
June 23, 2003



**MICHAEL O'NEILL**  
**PRIMARY EXAMINER**